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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/043,572 | 01/10/2002 | Neil Miles | IPPM Case 7 | 7931 |

7590 09/30/2002
FLYNN, THIEL, BOUTELL & TANIS, P.C.
2026 Rambling Road
Kalamazoo, MI 49008-1699

EXAMINER

MCCORMICK, SUSAN B

| ART UNIT | PAPER NUMBER |
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1661

DATE MAILED: 09/30/2002

2

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/043,572

Applicant(s)

MILES, NEIL

Examiner

Susan B. McCormick

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1661

Detailed Action

Drawings

The drawings have been approved by an official draftsman.

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163 (a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More specifically:

Art Unit: 1661

• A. The disclosure is objected to under 37 CFR 1.121(e) because the Latin name of the genus and species of the plant claimed should be preceded by the heading set forth in 37 CFR 1.163(c) (4).

B. Throughout the specification the Applicant has noted that “patent status unknown” for varieties listed. Applicant should be aware of the availability of the Patent and Trademark website, www.wspto.gov, to see if these varieties are patented or not.

C. Applicant must provide a color description for the observed variety with reference to a recognized color chart. The Royal Horticultural Society Color Chart (RHS), Maerz and Paul or Pantone are examples of suitable color charts. A color chart reference should include, for example, the trunk, branches, leaves (both surfaces), petals (both surfaces), fruit (skin and flesh), etc. See MPEP 1605.

D. Applicant should change the captions in the specification ([0004] and [0005]) provided in the drawings, replacing them with the figure numbers (FIG. 1, FIG 2, etc.) as the photographic illustrations and the specification must correspond to each other in this regard. No new drawings are required.

E. Applicant should set forth in the specification the age of the observed plant.

F. Applicant should be more descriptive with the comparison between the parents ‘Suncling’ and ‘New Jersey Cling 81’ and the observed plant, ‘V75024’ in how they differ from each other.

G. Additional information should be imported into the specification relative to the observed height and spread for the observed tree at a specified age and location of culture, and/or amount of growth over a specified period of time.

H. Information should be imported into the specification relative to plant vigor so as to more meaningfully describe same. Such could include, (for example) amount of growth over a specified period of time.

I. Applicant should set forth in the specification the trunk diameter (usually measured at a given height above soil level), texture and bark coloration in the interest of providing as complete a description of the observed plant as is reasonably possible.

Art Unit: 1661

J. If possible, Applicant should set forth a more detailed botanical description relative to branch size (diameter), color and internode length.

K. Applicant should disclose information regarding the amount (average per square inch), size (length and width) and color of the lenticels.

L. Applicant should disclose information regarding the shape of the apex and base, shape, margin, texture, color (both surfaces), venation pattern, vein color and leaf arrangement of the observed leaf.

M. Applicant should disclose the length, diameter and color of the petiole. The recitation "medium-long, longer than the comparative varieties" is vague and insufficient in this regard. Clarification is needed.

N. Applicant should disclose the shape, diameter, length and color of the flower bud of the observed plant.

O. Applicant should set forth in the specification the amount, size and color of the sepals.

P. Applicant should set forth in the specification the flower diameter as well as the size (length and width), shape, margin, color (both surfaces), texture, shape of the apex and base of the observed flower petal. The terms the Applicant has disclosed in the specification, i.e. "medium," "Burgundy," "elongated," and "medium pink" are vague and insufficient in describing the flower and petals. Correction is needed.

Q. Applicants should set forth an approximate date of bud burst and bloom time in the specified location of culture.

R. Applicant should set forth in the specification the reproductive organs and should disclose such information and describe these structures (colors, sizes, amount) in the interest of providing as complete a botanical description of the observed plant as is reasonably possible. The term the Applicant

Art Unit: 1661

has disclosed in the specification, i.e. "is above" (in describing the position of the stigma) is vague and insufficient in describing the reproductive organs. Correction is needed.

S. On pages 4 and 5, the terms and colors that are used in describing the observed fruit (for example, "medium-shallow," "medium-narrow," medium-small," "medium," "cream yellow," orange-yellow," "red," "tan," etc.) should be in quantitative measurements and referenced with an employed color chart.

T. The observed fruit weight should be disclosed in the specification.

U. Applicant should disclose information regarding the stone and kernel with regards to the size (length, diameter), color, texture and shape.

V. Applicant should disclose known shipping and storage characteristics of the observed variety, for example, the number of days the fruit has been stored under specific conditions.

W. Applicant should set forth the observed dates of first and last pick in the specified location of culture in the interest of providing as complete a botanical description as is reasonably possible.

X. Applicant should disclose information to the observed plant's winter hardiness and drought/heat tolerance.

The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Comments

Due to the amount of revision seen necessary in this application, it is suggested that Applicant file a substitute specification, incorporating all additions, deletions and modifications so as to provide the

Art Unit: 1661

printer a clean copy at the time of allowance. Applicant should specifically authorize cancellation of the present specification to the same.

Claim Rejection

35 U.S.C. § 112, 1st and 2nd Paragraphs

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above, and under 35 U.S.C. 112 first paragraph for the reasons advanced in the objection to the oath/declaration and objection to the drawings.

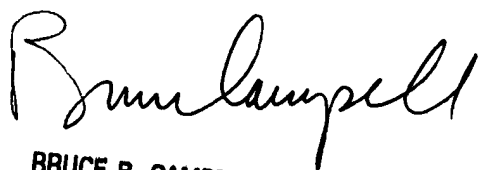
Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick whose telephone number is (703) 305-1682. The Examiner can normally be reached Monday through Thursday from 7:00 a.m. to 4:30 p.m. and alternate Fridays from 7:00 a.m. to 3:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

sbm


BRUCE R. CAMPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600